

phenylenediamine, 2-n-propyl-para-phenylenediamine, 2-hydroxymethyl-4-aminophenol, 3-methyl-4-aminophenol, 2-aminomethyl-4-aminophenol, 2-( $\beta$ -hydroxyethylaminomethyl)-4-aminophenol, 2-methoxy-4-aminophenol, 2-methoxymethyl-4-aminophenol, and acid-addition salts thereof;

- and at least one coupler;

wherein said second container contains an oxidizing composition comprising:

- at least one oxidizing agent.

### **REMARKS**

#### **I. Status of the Claims**

Claims 1-3, 5-9, 11-30, and 32-56 are now pending in this application. Claims 4, 10, and 31 have been cancelled without prejudice or disclaimer. Claims 1, 30, 33, 55, and 56 have been amended to delete selected second oxidation bases. These amendments are proper because Applicant is simply claiming less than the full scope of her original disclosure -- a perfectly legitimate procedure since it is for the inventor to decide what bounds of protection she will seek. See, e.g., *In re Johnson*, 194 U.S.P.Q. 187 (C.C.P.A. 1977).

Accordingly, no new matter has been added by these amendments nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment under 37 C.F.R. § 1.116 should allow for immediate action. The proposed amendments, moreover, place the claims in condition for allowance or, at least, in better form for appeal, if necessary.

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II. Rejections under 35 U.S.C. § 103

A. Henk I in view of Tsujino

Claims 1-27, 30-34, and 37-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Henkel (WO 92/13824) in view of Tsujino (U.S. Patent No. 4,961,925) for the reasons set forth on pp. 2-4 of the Office Action.

The Examiner states that it would have been obvious "to add a second oxidation base to Henkel's exemplified compositions in the claimed amounts ... and Tsujino teaches that the claimed second oxidation bases are conventional in the hair dyeing art." Office Action at p. 4.

Applicant respectfully disagrees for reasons of record. Nevertheless, to advance prosecution, independent claims 1, 30, 33, 55, and 56 have been amended to delete certain second oxidation bases. Thus, only a very specific, smaller set of bases is currently claimed. This set of second oxidation bases is neither taught nor suggested by Henkel and/or Tsujino. Furthermore, neither Henkel nor Tsujino teach or suggest a composition comprising the combination of first and second oxidation bases as now claimed.

Accordingly, no *prima facie* case of obviousness can be made over Henkel in view of Tsujino. The combination of references fails to teach or suggest all of the claim elements and equally fails to teach or suggest a motivation for modifying the references such that the presently claimed combination of components could be achieved.

M.P.E.P. §2143. In view of this failure of the references, Applicant respectfully requests withdrawal of this rejection.

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**B. Andrillon in view of Henkel**

Claims 1-7, 9-13, 15-38, 41-53 and 55-56 are rejected under 35 U.S.C. §103 over Andrillon (U.S. Patent No. 4,065,255) in view of Henkel (WO 92/13824) for the reasons set forth on pp. 4-7 of the Office Action. Applicants respectfully traverse this rejection for reasons of record and the following additional reasons.

Andrillon teaches the use of a particular class of couplers in oxidation dye compositions. Andrillon, however, fails to teach compositions comprising 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane. The Examiner cites Henkel to remedy this deficiency. The Examiner apparently believes that the combination is supported by Andrillon's teaching that mixtures of oxidation bases may be used. Office Action at p. 6, last 2 lines.

Applicant respectfully disagrees. Andrillon teaches the advantages of a particular class of couplers. Andrillon, however, does not teach that these couplers will especially benefit a composition comprising 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane or any phenoxy oxa-alkanes. While Andrillon's teaching may support the broad idea that more than one oxidation base can be used in hair dye compositions, there is no teaching or suggestion in either reference that a composition comprising Andrillon's coupler, 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane, and a second oxidation base is particularly desirable. Henkel does not remedy this deficiency because Henkel does not teach the use of Andrillon's specific couplers. "The prior art must suggest the desirability of the claimed invention." M.P.E.P. § 2143.01. As neither Andrillon nor Henkel provide this suggestion, a *prima facie* case of obviousness has not been established.

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Nevertheless, as discussed above, independent claims 1, 30, 33, 55, and 56 have been amended to recite a specific set of bases. Neither Andrillon nor Henkel provides a specific suggestion or motivation to use any of the second oxidation bases as claimed in amended claims 1, 30, 33, 55, and 56, with 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane.

Regarding independent claims 28 and 29, neither Andrillon nor Henkel teach the benefits of compositions comprising the combination of specific components set forth in these two claims. A *prima facie* case of obviousness made against these claims requires evidence of a specific suggestion from the art, as such evidence must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). See also *In re Lee*, 377 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority."). As the Examiner has failed to show how the references teach or suggest the specifically claimed combination of ingredients, a *prima facie* case of obviousness has not been established for claims 28 and 29.

In view of the above, Applicant respectfully requests withdrawal of this rejection.

### III. Conclusion

In view of the foregoing, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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